

## REMARKS

### I. STATUS OF THE CLAIMS

Claims 1-10 and 21 were pending in the present application. No claim amendments are presented with this response. Claims 1-10 and 21 thus remain pending in the present application. No new matter has been added.

### II. CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-10 are rejected under 35 U.S.C. §102(b) as being anticipated by Wahle et al. (US Patent No. 6,242,220) ("Wahle").

The Office Action states that in addition to steps (a), (b), and (c), part (iii), Wahle teaches "drying the sample on the support" (see e.g. Wahle, column 10 lines 16-17). Wahle also teaches "[a]n additional air drying of the sample takes place between process steps b) and c)" (see e.g. Wahle, column 10 lines 9-10).

Applicant respectfully disagrees. Wahle does not teach or suggest drying the sample on the support in accordance with the method of claim 1 of the present application as suggested by Examiner (see e.g. Wahle, column 10, lines 16-17). Applicant notes that the support the sample is dried on in step d) of the claimed method is the same support mentioned in step a). Thus, according to the claimed method, there must be no change of the support throughout steps a) to d). In fact, this is a basic principle of the present invention that the preparation of biological samples for analysis is performed on only one support during the method. Per Wahle, the first time drying the remaining sample is discussed, i.e. purified DNA pellet, appears in column 10, at lines 58-60. However, Wahle teaches that the sample has been processed on several different supports during the method. The mixture obtained from subjecting the sample to buffer P3, as disclosed in Wahle at column 10, lines 15 to 17, and asserted by the Examiner to represent step c) of the claimed method, is centrifuged and the supernatant thereof containing the DNA is removed, thus being put onto another support and subjected to further centrifugation (see Wahle in column 10, lines 22 to 30). The supernatant thereof is subjected to filtration, which necessitates a further change of

the support. Subsequently, the sample is again centrifuged and eventually washed and dried in a tube. Therefore, Wahle teaches changing the support several times and does not provide any teaching which would lead the person skilled in the art towards the claimed invention.

With respect to the Examiner's remark that Wahle allegedly discloses an additional air drying of the sample between process steps b) and c) in column 10, lines 9 to 10, it is respectfully submitted that the sample being "incubated at room temperature for 5 minutes" is not relevant to drying the sample, but indicates the temperature of incubating the sample in buffer P2. It is well known that 20 ml of a chilled buffer P2 would not evaporate at room temperature within 5 minutes and would not be a rational conclusion to the person skilled in DNA purification methods.

Therefore, it is submitted that Wahle does not anticipate applicant's claimed invention and applicant requests withdrawal of the 102 rejection.

### **III. CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

Claims 1-10 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Stapleton (US Patent No. 5,436,129) ("Stapleton") in view of Wahle et al. (US Patent No. 6,242,220) ("Wahle"). Applicant asserts that the Examiner has not established a prima facie case for obviousness. The prima facie case for obviousness has not been met because even if combined, the references do not teach or disclose the claimed invention.

The Office Action states that Stapleton discloses a method for preparing biological samples for analysis comprising applying the sample to a slide, applying a solution to the sample to denature the protein, changing a temperature of the sample and drying the sample between treatments. The Examiner acknowledges that Stapleton does not teach applying a protein denaturing solution at one temperature, then leaving the solution while lowering the temperature. However, according to the Examiner, it would have been obvious to apply the protocol of Wahle to the slide preparation of Stapleton in order to gain the advantages of shorter preparation time.

Applicant respectfully traverses and notes that the prior art must enable the claimed method against which it is cited in order to support an obvious rejection. Stapleton does not disclose any particular conditions according to which the method should be performed. Furthermore, the combination of Stapleton and Wahle as proposed by the Office Action would destroy the respective teachings. For example, Wahle teaches the use of a lysis buffer P2 and a neutralization buffer P3 for denaturing and precipitation of protein and cell debris (see Wahle in column 10, lines 8-20). On the other hand, Stapleton, as cited by the Examiner, teaches using a lysis buffer and subsequent alkaline treatment. Therefore, Wahle and Stapleton are related to very different treatments of the sample. Accordingly, a person skilled in the art could not and would not have applied the protocol of Wahle to that of Stapleton.

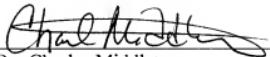
Furthermore, as mentioned in connection with the 102 rejection, Wahle does not teach drying the sample on the same support. Accordingly, there is no motivation for the person of ordinary skill in the art to turn to Wahle. Moreover, there is no reasonable expectation of success for the person skilled in the art when applying the method steps of Wahle to the method of Stapleton. For example, in Stapleton, the sample on the matrice remained intact and subsequent amplification by PCR would work. It is emphasized again that while Stapleton may teach leaving the sample on a matrice for further processing in PCR amplification, Wahle teaches a purification method wherein the sample is processed to different supports several times. Accordingly, there is no motivation for the person skilled in the art to combine the teachings of Wahle with those of Stapleton and there is no reasonable expectation of success to arrive at the claimed method.

Therefore, it is submitted that Stapleton alone, or in combination with any of the prior art, does not obviate applicant's claimed invention and applicant requests withdrawal of the 103 rejection.

**CONCLUSION**

In view of the above amendments and remarks, Applicant respectfully asserts that the rejections set forth in the Office Action have been fully addressed and overcome. Hence, Applicant asserts that all Claims are in condition for allowance and requests that an early notice of allowance be issued. If issues may be resolved through Examiner's Amendment, or clarified in any manner, a call to the undersigned attorney at (404) 879-2479 is respectfully requested.

Respectfully submitted,

  
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